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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,810	07/08/2003	John W. Dankwardt	021153-001900US	1458
40853	7590	11/29/2005	EXAMINER	
KILPATRICK STOCKTON LLP - 46395			BROWN, JENNINE M	
ATTN: CHARLES CALKINS			ART UNIT	
1001 WEST FOURTH STREET			PAPER NUMBER	
WINSTON-SALEM, NC 27101			1755	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,810

Applicant(s)

DANKWARDT, JOHN W.

Examiner

Jennine M. Brown

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 19-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/27/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Examiner has agreed to add claim 18 into the examined limitations, assuming that the omission of claim 18 was inadvertent, therefore claims 19-27 stand as withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/11/05.

The requirement is still deemed proper and is therefore made final.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase, "conditions sufficient to produce the coupled aromatic compound" is indefinite because when one looks to the specification, only comparative examples are given and it is unclear whether these are to represent prior art examples or applicant's own work. According to US practice it is common for "comparative examples" to represent work done by others and "examples" to represent work done by the applicant.

Examiner respectfully disagrees with applicant's arguments regarding interpretation of the claims in light of the specification because applicant includes at

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least 18 different (comparative) examples (e.g., in situ generation of nickel catalyst, separate addition of the nickel catalyst, addition of 2 additional equivalents of the phosphorus ligand, use of THF or toluene solvent) and it is unclear what the metes and bounds of the claimed limitation are to encompass with regard to the order of contacting the materials, the amount of materials required, the duration of the contact and the temperature at which these materials are contacted. Examiner points out that the entire method may turn upon the manner in which each of the components are reacted.

### ***Claims Analysis***

The examiner is interpreting "wherein" as a transitional phrase equivalent to "comprising". See MPEP 2111.02.

The examiner is interpreting claim 1 in light of the preamble because the method breathes life into the claim.

### ***Claim Objections***

Claims 2-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims for the reasons given below.

### ***Allowable Subject Matter***

Claims 13-18 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Prior art of record fails to fairly teach or disclose applicants method of coupling

an aryl or heteroaryl magnesium compound with an aryl ether compound in the presence of a nickel phosphine catalyst. Prior art of record uses aryl halides in the presence of aryl or heteroaryl magnesium compounds in the presence of a nickel phosphine catalyst but fails to specifically teach or disclose the use of the aryl ether compound as in the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
J. A. LORENZO  
SUPERVISORY PATENT EXAMINER